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| 09/882,596      | 06/15/2001  | Ursula Murschall     | 00/149-2 MFE        | 8301             |

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EXAMINER

SZEKELY, PETER A

|          |              |
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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/882,596

Applicant(s)

MURSCHALL ET AL.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1--9 and 11-22 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not known whether the cited molecular weight of the carbodiimide is weight average, number average, viscosity average, peak average or Z average molecular weight.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The claim contains improper Markush language. And/or is treated the same way as "and" is.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 11, 12 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Yatsu et al. 4,390,683, Murschall et al. 5,302,427, Murschall et al.

5,366,796, Schuhmann et al. 5,554,245, Schuhmann et al. 5,429,862, Schuhmann et al. 5,433,983, Peiffer et al. 5,468,527, Dries et al. 5,529,843 or Peiffer et al. 5,914,079.

8. Yatsu et al. disclose biaxially stretched polyester in the Abstract, quenching to form a transparent sheet in Example 1, hindered phenols and phosphites in column 8, lines 12-17 and heat set in Examples 2-5. Murschall et al. ('427) teach a biaxially oriented polyolefin multilayer film and masterbatching in the Abstract, transparency in column 2, line 17, heat setting in column 2, line 52, corona treatment in column 3, line 32, hindered phenols in column 10, lines 23-25 and masterbatching a portion of the polyolefin mixture in column 2, lines 53-60. The contents of Murschall et al. ('796) are similar. Schuhmann et al. ('245) recite biaxially oriented film in the title, sterically hindered phenols with phosphites in column 4, lines 14-67, heat setting and corona treatment in column 5, lines 22-26 and transparent film in Example 1. The contents of the other two Schuhmann et al. patents are similar. Peiffer et al. ('527) divulge transparent film in the title, biaxial stretching, heat setting and corona treatment in column 2, lines 58-67 and hindered phenols in column 5, lines 21-26. The contents of Peiffer et al. ('079) are similar. Dries et al. reveal biaxial stretching, heat set and corona discharge in column 2, lines 30-34, transparency in column 2, line 47 and hindered phenols in column 8, lines 3-9. Applicants' claims are not novel.

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***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the primary references of paragraph #8, in view of Murakami et al. 4,264,667, Matsumura et al. 4,517,315, Brozek et al. 5,138,024, Anderson, II 5,324,467, Rogers et al. 5,804,626, DeNicola, Jr. et al. 6,218,023, Wakabayashi et al. 6,355,336, Bland et al. 5,427,842, Longmore et al. 6,497,965 or Nisshinbo Industries, Inc EP 0 803 538.

12. The primary references have been discussed already. Murakami et al. display a transparent polyester film in the Abstract, UV absorber, antioxidant and flame retardant in column 7, lines 8-11, biaxial drawing in column 7, line 17, corona discharge in column 8, line 36 and heat set in Example 1. Matsumura et al. describe heat setting a polyester

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film in the Abstract, biaxial stretching in column 11, line 48, heat set in column 11, line 30 and 2,2'-bis (2-oxazoline) in column 17, lines 50-53. Brozek et al. describe a clear heat set film containing phosphites in the Abstract, biaxial orientation and heat setting in column 10, lines 21-24 and a blend of hindered phenol with phosphites in column 11, lines 11-14. Anderson, II presents flame-retardants in column 3, line 4, biaxially oriented film, transparency and heat set in Example 1 and corona treatment in Example 2. Rogers et al. show a polyester composition, which can be a film with polymeric carbodiimides in the Abstract and molecular weights in column 6, lines 25-27, phosphorus and halogen flame retardants with hindered phenols in column 7, lines 22-27. DeNicola, Jr. et al. show a stabilizer masterbatch of UV stabilizer phosphite and hindered phenol being added to polypropylene film in column 15, lines 12-25. Wakayabashi et al. relate polyester, hindered phenol and phosphite in column 4, lines 15-19, heat set in column 6, line 16, biaxial stretching in column 7, lines 49-54 and transparency in column 7, line 62. Bland et al. report biaxial orientation in column 3, line 39, polyethylene oxazoline in column 7, lines 9-10, UV stabilizers in column 11, line 6, corona discharge in column 11, line 33, biaxial orientation in column 12, line 11 and heat set in column 12, line 37. Longmore et al. list flame retardants in column 5, line 47, corona discharge in column 6, line 5, biaxially drawn film and heat set in column 6, lines 48-56. Nisshinbo Industries cites a hydrolysis stabilizer for polyesters, which is a carbodiimide in the Abstract. It would have been obvious to one having ordinary skill in the art, at the time the invention was made to add hindered phenols and phosphites in the amounts shown by the secondary references and add them as a masterbatch to

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ensure good stability and superior dispersion as shown by DeNicola, Jr. et al. and Brozek et al. and use oxazoline for better adhesion and carbodiimide for hydrolysis resistance, since that improves the properties of the composition. The addition of flame-retardants and UV stabilizers is also known and customary. Applicants' specific UV stabilizers and flame-retardants are known and do not add anything to the instant invention which another flame retardant or UV absorber would not do.

***Allowable Subject Matter***

13. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is 703-308-2460. The examiner can normally be reached on Tuesday-Friday 7:00 a.m.-5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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A handwritten signature in black ink, appearing to read 'Peter Szekely', with a stylized flourish at the end.

Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.  
March 17, 2003